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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/765,270	01/18/2001	William Gross	IDEALAB.001A	6161

7590 06/01/2004

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/765,270

Applicant(s)

GROSS, WILLIAM

Examiner

James S McClellan

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mw

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>8, 11</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Amendment*

1. Applicant's submittal of an amendment was entered on March 8, 2004, wherein:  
claims 1-22 are pending and  
claims 1,8, 15, and 20 have been amended.

### *Information Disclosure Statement*

2. Applicant's submission of Information Disclosure Statements on March 8, 2004 and May 20, 2004 have been fully considered as indicated by the returned PTO-1449's attached to this office action.

It is noted that numerous references listed on each PTO-1449 are duplicates of references previously cited on an PTO-892 in this application, references cited on the same PTO-1449, or references cited on an earlier PTO-1449. The Examiner requests that Applicant carefully review all future Information Disclosure Statements for duplicate references such that the Examiner may more efficiently spend the time available to examine the case on items of merit instead of reconsidering duplicate references. Additionally, the Examiner amended the citation for reference number A60 on the March 8, 2004 PTO-1449 to include the date of publication.

### *Claim Rejections - 35 USC § 102*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 5, 15, 16, and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Internet Publication to Ebay ([www.ebay.com](http://www.ebay.com)) available on [www.archive.org](http://www.archive.org).

The Ebay Publication was published on 4/28/99 (see page 1, "Last Updated: 4/28/99") and was accessed on 9/3/03 via an Internet archive website ([www.archive.com](http://www.archive.com)).

Regarding **claim 1**, Ebay discloses ranking offerings offered by at least one on-line vendor, comprising: operating a ranking module (using the Feature Auction option, see page 8, wherein the vendor selects whether to use the "Feature Auction" option to place their product at the top of the page, wherein Ebay receives a fee from the vendors that decide to use the "Feature Auction" option) affiliated with a first entity (Ebay), receiving a search parameter of a user (see page 1, "Search" input); identifying at least a first offering from an on-line vendor and a second offering from an on-line vendor that match the search parameter (see page 2, "Featured Auction", "Appear at the very top of the listings"); and ranking, with the ranking module, the first offering relative to the second offering so as to increase income received by the first entity (Ebay); [**claim 2**] calculating an estimated first selection revenue that corresponds to the revenue received by the first entity (Ebay) when a user selects the first offerings; and calculating an estimated second selection revenue that corresponds to the revenue received by the first entity (Ebay) when the user selects the second offering; and [**claim 5**] calculating an estimated first purchase commission (Feature Auction fee of \$99.95; see page 8) that corresponds to the commission received by the first entity (Ebay) when a user purchases an item offered in the first offering; and calculating an estimated second purchase commission that corresponds to the

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commission received by the first entity (Ebay) when a user purchases an item offered in the second offering.

Regarding **claim 15**, Ebay discloses a system that ranks offerings by at least one on-line vendor as set forth above for method claim 1. Ebay is relied upon to reject **claims 16 and 18** for same reasons that similar claims 2 and 5 were rejected in the above paragraph.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3, 4, 6-14, 17, and 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ebay Publication in view of U.S. Patent No. 5,664,115 (Fraser).

The Ebay Publication discloses the method and systems as set forth above, but fails to explicitly disclose estimating a purchase likelihood by a user.

Fraser teaches the use of estimating a purchase likelihood by a user (see column 5, lines 27-34 and column 9, lines 2-7).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ebay Publication with user purchasing likelihood information as taught by Fraser, because determining the likelihood of a user's desire to purchase a product will allow the selling entity to more efficiently display items for purchase to the potential buyer.

*Response to Arguments*

7. Applicant's arguments filed March 8, 2004 have been fully considered but they are not persuasive.

On page 11, fourth paragraph, Applicant argues that the Ebay Publication is not applicable because a Featured Auction "may appear" at the top of the main page. The Examiner respectfully disagrees. A Featured Auction item will appear at the top of the "main Listing page" for that result (see page 2, "Featured Auction"; see also page 8, "Featured Auction"). Applicant is apparently referencing an additional feature of the Featured Auction that randomly selects Featured Items to appear on the Featured display area of the "main eBay Home page".

On page 11, fifth paragraph, Applicant argues that Ebay fails to disclose ranking search requests against first and second vendors. The Examiner respectfully disagrees. On page 2, under "Featured Auction" it states that featured auctions "appear at the very top of the listings" (emphasis added by the Examiner). The term "listings" indicates more than vendor listed items.

On pages 11-12, sixth paragraph, Applicant argues that Ebay fails to disclose revenues and commissions. The Examiner respectfully disagrees. Ebay charges a revenue (for example, the \$99.95 Featured Auction) and commissions (for example, a final value fee; see page 8).

On page 12, third full paragraph, Applicant argues that Fraser does not define what he means by "the likelihood that a particular buyer can or will purchase a particular property". Applicant alleges that a purchase likelihood of Fraser is simply a financial evaluation of whether the potential buyer can afford the property. Applicant is partially correct. Fraser determines if a buyer can purchase a particular property by a financial evaluation. However, Fraser also determines if a buyer will likely make the purchase given the information obtained from the

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buyer (see column 9, lines 1-7). Therefore, Fraser teaches determining a purchase likelihood as required by the claims.

On pages 12-13, Applicant argues that there is not suggestion to combine the references. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the Ebay Publication with user purchasing likelihood information as taught by Fraser, because determining the likelihood of a user's desire to purchase a product will allow the selling entity to more efficiently display items for purchase to the potential buyer.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

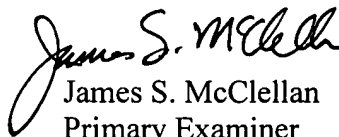
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks  
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or  
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,  
Arlington, VA, 7<sup>th</sup> floor receptionist.

  
James S. McClellan  
Primary Examiner  
A.U. 3627

jsm  
May 28, 2004